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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,996	12/10/1999	YUKO S. NISHIKAWA	080398.P230	1826

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD, SEVENTH FLOOR
LOS ANGELES, CA 90025

EXAMINER

BOCCIO, VINCENT F

ART UNIT PAPER NUMBER

2615

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/466,996

Applicant(s)

NISHIKAWA ET AL.

Examiner

Vincent F. Boccio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-18, 20, 27, 33, -34, 37, 41, 44 is/are allowed.
- 6) ☒ Claim(s) 1-8, 12-15, 19, 21-26, 28-32, 35, 36, 39, 40, 42 and 43 is/are rejected.
- 7) ☒ Claim(s) 9-11 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION
Response to Arguments

1. Applicant's arguments with respect to claims 7-8 and related claims, etc., have been considered but are moot in view of the new ground(s) of rejection, not necessitated by amendment.

2. Some of Applicant's presented arguments filed 12/19/03 have been fully considered but they are not persuasive.

{A} In re page 13, applicant states, "The OSD does not display a graphic treatment.

In response the claim recites, "a graphic treatment for the title based on the content data", is deemed met, in view of,

the treatment of the title is met by the OSD and the placement of the data on the frame by superimposing the titling on a location on the frame, which is graphically treating the titling data by placing the titling and superimposing, which is based on the content data received for the title,

wherein the OSD treatment by placement of the titling, reads on the OSD inherent operation, thereby providing at least one treatment, by any OSD superimposing information, as is understood by those skilled in the art.

{B} In re page 14 applicant states, with respect to Her, "First, the switch is used to select either a superimposed signal or a standard signal, not select either recording title or not. Second, the switch is used not in the state of a titling mode (Her, col. 2, lines 47-48), Third, the switch is not use to select generating and recording a title frame".

In response, the examiner fails to agree. As stated by applicant, the switch is used to select either the superimposed signal or a standard signal.

It is clear applicant fails to understand the reference, the switch allows a user to include the tile which is provided by superimposing a signal on the video signal (the superimposed signal), or to record the standard signal, which does not have the superimposed title, wherein the switch is the means to determine titling or not, controlled by the user, therefore, is a means for user control if a title is provided to not.

Therefore meeting the limitation of providing a user with an option, when not selected or based on the switch providing

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the standard signal for recording, the option is not exercised, wherein upon switching or enabling recording of the superimposed signal, a title signal generated is recorded, by, being superimposed based on the user option to control the switch provided.

First, the switch is used to select either a superimposed signal or a standard signal, not select either recording title or not, wherein the examiner agrees,

Second, the switch is used not in the state of a titling mode, the examiner fails to agree,

the switch is used in a state of a titling mode, wherein the switch is used to direct the video signal superimposed with the title to be recorded.

Third, the switch is not used to select generating and recording a title frame, but, the switch is used to select the signal with the generated title.

Wherein claim 2, merely claims a title frame recording option, which the switch positions dictate the options, provided for selection by the user.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1, 3-4, 6, 13, 15, 19, 21-25, 28-31, 35, 39-40 and 42-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Hailey (US 6,215,951).

Regarding amended claim 1, original claims 3-4 and 6, the examiner incorporates by reference the last action against the claims.

Further the examiner will consider the added claim language to the claims, amended to claim 1, such as: "the title frame including one of customized information and the received program information".

Althou, Hailey is deemed by the examiner to still

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anticipate based on the broad claim language used and further the examiner renders claim 39 to also be met based on the broad claim language presented.

O generating a title being one of a customized information and the received program information, as interpreted,

when one provides title it is customizing a frame with to the specific title used,

furthermore, Hailey also reads on using the received program information or title to customize a title frame prior to recording, met by Hailey.

Further to address the claims limitations of claims 39, Hailey further meets the limitation of wherein the customized program information is

one of extracted program description ("MET BY THE TITLE", which is customizing information for customizing a title frame, or the frame prior to the received program information, by providing a title to the frame, thereby meeting the limitation of customizing the frame),

- o or, "a user's program information",
- o or, "a selected graphic treatment", since the claims 1 and 39 both recite one of.

Claim 13, is analyzed and discussed with respect to the arguments answered and the claims above, wherein all OSD have an inherent graphic treatment is view of placement of the Titling on a Title frame.

Regarding claims 21-25 and 39, Hailey after a careful consideration by the examiner and the claim language recited, is further deemed to read on the recited limitation of wherein the customized program information (customized in view of being for a specified program), is one of extracted program description (met by the title is program description information)

or user's program description (not met by Hailey)
or a selected graphic treatment (also consider met by the superimposing element, provides a graphic treatment to the titling information by placing the information on a frame), wherein the program information is used to generate description in the title frame, the

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description met by the title.

Regarding claim 15, Hailey further meets the limitation of wherein the content data is a categorization of the program content, by titling with a title, therefore, categorized.

Claims 19, 28-31, 35, 40, 42-43, has been analyzed and discussed with respect to the claims above, such as claims 1 and 39 etc...

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 2, 14, 26, 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hailey (US 6,215,951) in view of Her (US 5,469,224).

Regarding claims 2, Hailey fails to disclose wherein the user selects an option to generate a title or not, or a user activated option to either provide a title or not.

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Regarding claim 14, Hailey fails to provide a means for the user to select an auto title frame recording option.

Regarding claim 26, Hailey fails to disclose an input means for accepting a user's command to activate a title frame recording option.

Regarding claim 32, Hailey fails to disclose a user selecting a title frame recording option, wherein based on this user selection, titles are provided or not.

Regarding claim 36, Hailey fails to disclose a user selecting an automatic title frame recording option.

Her teaches providing a user the option, thru a switch as shown in Fig. 3, ASW 13" to either provide a title to the recording or not (col. 2, lines 45-, ASW13 on or off in order to select the superimposed signal or a standard signal as a recording signal), thereby providing a mean to a user an option to either title or not the recording, as taught by Her.

Further regarding claim 14, Her provides a means for auto-title frame recording option in view of the switch, once set automatically record titling when recording.

Her teaches and reads on the claim language of, a means for a user to provide a command, in the form of controlling a switch to activate the means titling a frame, is also taught by Her.

Further Her's OSD also reads on a selected graphic treatment, one being available, which is the placement of the OSD information or title on the screen, dictated by the OSD.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Hailey by incorporating, "the option", "input means for accepting a user's input", to the user to record a title or not as desired, as taught by Her, wherein after being set or commanded to providing titling to the recordings, will automatically record the titling thereafter, by recording the OSD signal, as taught by Her.

4. Claims 5, 7-8, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hailey (US 6,215,951) in view of Yuen et al. (US 6,487,362).

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Regarding claims 5, 7, 12, Hailey discloses and meets the limitation associated with a method of recording program content of a transmission comprising:

- receiving program information;
- generating a title frame
- recording the title frame prior to recording the program content
- placing the received program information of the title frame, as applied above.

Regarding claim 5, wherein Official Notice has been taken, stating it would have been obvious to utilize selecting a graphic treatment corresponding to genre information, wherein the graphic treatment correspond to the type of information.

Hailey suggests alternative information col. 2, lines 47-49, "additional content description text may be helpful to the viewing to ID the program, recorded".

Further as applied above Yuen provides for user entered title information (col. 110). Therefore, based on the teachings and suggestions, it would have been obvious to one skilled in the art to modify Hailey by allowing a user to dictate the title further to utilize additional information {available to a user}, such as genre, to create a title frame, identifying a recorded program, as suggested by the combination.

Regarding claim 7, Hailey fails to disclose generating a title frame from customized information which is provided from the user, wherein the can create a title or to customize the title frame, and further wherein placing the received program information in the title frame corresponding to a default setup, it the user does not select a title.

Regarding claim 8, based on the combination as applied meets the limitation of wherein the customized program information is one of an extracted title (MET), or a user's program description (also MET), or a selected graphic treatment (which is deemed inherent that all title gererators are programs to control and therefore, treat the superimposed title data, as is inherent is known to those skilled in the art).

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Regarding claim 12, Hailey fails to disclose using a default title frame when no content information is available for the program.

Yuen teaches at cols. 109-110, col. 110, lines 15-, and teaches, "If no title is detected", then a default is inserted, such as channel, date and time;

Yuen further teaches, "user generated title", wherein when no title is detected and the user has not generated one, the default event information set for recording is used, being channel number, time and date for example, as taught by Yuen.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Hailey by providing the user an option to dictate the titling information, generated by the user, further obvious upon no title by the user and no title detected from the broadcast to utilize a default, as taught by Yuen, thereby providing a default title when the user does not provide and the broadcast title information is not detected, as taught by Yuen.

Allowable Subject Matter

1. Claims 9-11, 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
2. Claims 16-18, 20, 27, 33, 34, 37, 41, 44 are allowed.

Contact Fax Information

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

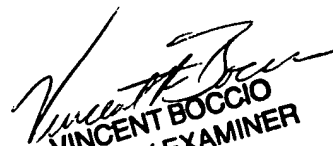
Contact Information

1. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent
3/22/04


VINCENT BOCCIO
PRIMARY EXAMINER